

REMARKS/ARGUMENTS

Claims 18-19 are cancelled; Claims 1, 15-17 and 20 are amended; Claims 21-25 are new.

Amended Claim 1 is supported at previously presented Claim 1 and at previously presented Claims 15 and 17, the contents of which are incorporated into Claim 1. Amended Claims 15 - 17 are supported, respectively, at previously presented Claims 15 - 17. Amended Claim 20 is supported at previously presented Claim 20 and at previously presented Claim 15, the contents of which are incorporated into Claim 20. New Claims 21-22 are supported at Claim 1. New Claims 23-25 are supported at Claim 20.

No new matter is added.

Applicants thank Examiners Palenik and Sheikh for the helpful and courteous discussion of August 27, 2010, wherein proposed amendments to Claims 1 and 20, as well as addition of possible new claims, were discussed as possible options to address the rejections of record, and wherein Applicants agreed to file an RCE along with this response. The Examiners' time and willingness to consider the amendments and arguments of this paper are truly appreciated.

In the Advisory Action of June 24, 2010, Examiner Palenik indicated that the Amendment of June 1, 2010, was entered, and that the Amendment was sufficient to overcome the indefiniteness rejection of Claims 13-14. Accordingly, this rejection is not further treated in this paper.

The anticipation rejection of Claim 20 as being unpatentable in view of Bajaj is traversed. The Office characterizes Bajaj's solvents as de-ionized water or de-ionized water/acetone.¹ In present Claim 20, the at least one biocompatible, water-miscible solvent is selected from the group consisting of N-methylpyrrolidone, dimethylethylamide, diethylene

¹ See Official Action page 4.

glycol dimethyl ether, ethyl lactate, ethanol, dimethoxyethane, dimethylsulfoxide, glycofurol, and combinations thereof. While these solvents may contain some reasonable amount of water (they need not be anhydrous), the fact nevertheless remains that they contain predominantly non-water solvent molecules, and these are not de-ionized water or de-ionized water/acetone. Further, even though Claim 20 employs the term “comprising,” because the at least one biocompatible, water-miscible solvent is selected from a Markush group, addition of further solvents such as water (other than a reasonable amount of water present in the solvents) is prohibited. Accordingly, Bajaj does not describe or suggest all of the features of Claim 20. Withdrawal of the rejection is requested.

The obviousness rejection of Claims 1-3, 5, 11 and 17 as being unpatentable in view of Leshchiner is traversed. Leshchiner requires that his gel slurries be formed in an aqueous medium.² At page 4, lines 37-38, Leshchiner describes an aqueous solution as “an aqueous solution of a salt or other low molecular weight substance.” Leshchiner further elaborates on an aqueous medium / aqueous solution at page 4, line 48-page 5, line 11. In Example 1, the aqueous solvent is water.³ Accordingly, Leshchiner’s solvent is water. Contrastingly, in Claim 1 and the claims depending therefrom, the at least one biocompatible, water-miscible solvent is selected from the group consisting of N-methylpyrrolidone, dimethylethylamide, diethylene glycol dimethyl ether, ethyl lactate, ethanol, dimethoxyethane, dimethylsulfoxide, glycofurol, and mixtures thereof. These solvents are mostly or completely non-water solvent, and not predominantly water as found in Leshchiner. Accordingly, Leshchiner does not describe or suggest all of the features of Claim 1 and its dependent claims. Finally, Leshchiner, in requiring a water solvent, “teaches away” from the above listed claim feature.

² See Leshchiner, Abstract.

³ Id., page 8.

Even though Claim 1 employs the term “comprising,” because the at least one biocompatible, water-miscible solvent is selected from a Markush group, addition of further solvents such as water (other than a reasonable amount of water present in the solvents) is prohibited. Leshchiner does not describe or suggest all of the features of Claim 1 and the claims depending therefrom, and “teaches away” from a claim feature. Withdrawal of the obviousness rejection is requested.

The obviousness rejection of Claims 6-10 and 12-14 as being unpatentable in view of Leshchiner and van Bladel is traversed. Claims 6-10 and 12-14 depend, either directly or indirectly, from Claim 1. As described above, Leshchiner does not describe or suggest at least the solvent feature of Claim 1 and its dependent claims; and Leshchiner, in requiring a water solvent, “teaches away” from the claimed solvent feature. Leshchiner’s deficiencies are not cured by van Bladel, whom the Office relies upon to provide sized particles.⁴ Withdrawal of the rejection is requested.

The obviousness rejection of Claim 20 as being unpatentable over Chang is traversed. As described by the Office, Chang requires aqueous solutions or dispersions.⁵ In Claim 20, the at least one biocompatible, water-miscible solvent selected from the group consisting of N-methylpyrrolidone, dimethylethylamide, diethylene glycol dimethyl ether, ethyl lactate, ethanol, dimethoxyethane, dimethylsulfoxide, glycofurol, and combinations thereof. While these solvents may contain some reasonable amount of water (they need not be anhydrous), the fact nevertheless remains that they contain predominantly non-water solvent molecules (these are not primarily water based solutions). Further, even though Claim 20 employs the term “comprising,” because the at least one biocompatible, water-miscible solvent is selected from a Markush group, addition of further solvents such as water (other than a reasonable

⁴ See Official Action page 10.

⁵ Id. at page 11.

amount of water present in the solvents) is prohibited. Accordingly, Chang does not describe or suggest all of the features of Claim 20. Withdrawal of the rejection is requested.

The obviousness rejection of Claims 4 and 15-16 as being unpatentable in view of Leshchiner and Chang is traversed. Claims 4 and 15-16 depend directly or indirectly from Claim 1. As described above, in Claim 1, the solvent is not primarily water but the solvent in Leshchiner and Chang is primarily water. The references, alone or in combination, do not describe or suggest, and "teach away" from, the solvent feature of Claim 1 and the claims depending therefrom. Withdrawal of the obviousness rejection is requested.

Applicants submit the present application is now in condition for allowance. Early notification to this effect is earnestly solicited.

Respectfully submitted,

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